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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANTS : TELGENBUSCHER et al.  
SERIAL NO. : 09/902,055  
FILED : 10 July 2001  
FOR : METHOD OF AT LEAST PARTLY COATING BACKING MATERIALS  
ART UNIT : 1762  
EXAMINER : Katherine A. Bareford

7 June 2004

**Mail Stop: Appeal Brief - Patents**  
Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22312-1450

**APPELLANTS' REPLY BRIEF ON APPEAL  
PURSUANT TO 37 CFR § 1.193(b)(1)**

SIR:

The appellants stand by the arguments previously presented in the Appeal Brief of 17 February 2004 but wish to make a few brief comments about the Examiner's Answer.

The Examiner makes six separate citations to *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) in her answer which, based on the description preceding the citation, is presumably from MPEP 2143.01 - "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

However, the appellants note that despite having a fact pattern which was more indicative of obviousness than the fact pattern of the present application, the ultimate decisions of *In re Fine* and *In re Jones* resulted in the Examiner's rejection being reversed which is later described in MPEP 2143.01 (see passage below):

"In *In re Fine*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

In *In re Jones*, the claimed invention was the 2-(2 $\phi$ -aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed *inter alia* the substituted ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention. " (emphasis added)

Moreover, the appellants' also point to another passage from within *In re Fine*:

"Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art.' *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.' *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And 'teachings of references can be combined *only* if there is some suggestion or incentive to do so.' *Id.* **Here the prior art contains none.**

Instead, the Examiner relies on hindsight in reaching his obviousness determination...

It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention **and cast the mind back to the time the invention was made...**to occupy the mind of one skilled in the art **who is presented only with the references**, and who is normally guided by the then-accepted wisdom in the art.' *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 1599, 1600 (emphasis added).

There is simply no reason to believe that one of ordinary skill in the art having any of the references cited by the Examiner in her rejections but without the benefit of the appellants' claims to act as a guidepost given the numerous differences between the primary reference and the appellants' claimed invention.

It is well known that "'virtually all [inventions] are combinations of old elements...Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Sensotronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

The appellants believe that the Examiner has improperly relied on picking and choosing of elements from the cited references and substituted her own opinions for the teaching, suggestion or motivation necessary to combine the prior art references and therefore, these rejections should be reversed.

For the foregoing reasons and for the reasons advanced in Appellants' principal brief, Appellants respectfully request that the Honorable Board reverse the final rejection.

NOTE: With regard to the groupings of the claims, it appears that the different positions represented by the Examiner and the appellants' with respect to the rejection of the claims is related to the differing positions as to how the claims should be grouped. The appellants' primary position is that obviousness requires all claim limitations must be taught or suggested by the prior art. see MPEP 2143.03. The appellants believe that the elements represented by claims 3-6, 9, 10 and 17-19 have not been taught or suggested by the prior art whereas the Examiner believes these are merely obvious or optimized variations of the prior art invention.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

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Date: 7 June 2004